



# UNITED STATES PATENT AND TRADEMARK OFFICE

MLJ

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/405,731	09/24/1999	THOMAS L. DISTEFANO III	6676.5	9812

7590 03/16/2004

QUARLES & BRADY LLP  
222 LAKEVIEW AVENUE SUITE 400  
P O BOX 3188  
WEST PALM BEACH, FL 334023188

EXAMINER
----------

GRAHAM, CLEMENT B

ART UNIT	PAPER NUMBER
----------	--------------

3628

DATE MAILED: 03/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/405,731

Applicant(s)

DISTEFANO III, THOMAS L.

Examiner

Clement B Graham

Art Unit

3628

Mk

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>Z</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Claims 1-20 remained

#### *Claim Rejections - 35 USC § 101*

2. 35 U.S.C. 101 reads as follows:  
teach a technological requirements.

For a claim to be statutory under 35 USC 101 the following two conditions must be met:

1 Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-20, are rejected under 35 U.S.C. 101 because the claimed invention is

not supported by either a specific and substantial asserted utility or a well established utility. The claimed invention is noted not to be a computer program, data structure, a natural phenomenon, and a non-descriptive material per se. Furthermore, the claimed invention do not produce a useful, concrete and tangible result therefore they are nonstatutory. The claimed invention also is not a product for performing a process, nor it is a specific machine or manufacture. The claimed invention is not a specific tangible machine or process for facilitating a business transaction.

As to the technology requirement, note MPEP Section iV 2(b). Also note In Re Waldbaum, 173USPQ 430 (CCPA 1972) which teaches "useful arts" is synonymous with "technological arts". In re Musgrave, 167USPQ 280 (CCPA1970), In re Johnston, 183USPQ 172 (CCPA 1974), and In re Toma, 197USPQ 852 (CCPA 1978), all) In the claim, the practical application of an algorithm or idea result in a useful, concrete, tangible result, AND

- 2) The claim provides a limitation in the technological art that enables a useful, concrete, tangible result.

#### *Claim Rejections - 35 USC § 102*

Art Unit: 3628

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-20, are rejected under 35 U.S.C. 102(e) as being [anticipated] by Ginter et al(Hereinafter Ginter U.S. Patent No.5 ,949, 876.

As per claim 1-20, Ginter discloses a method for moderating external access to an electronic document authoring, development and distribution system comprising the steps of, identifying a third party requesting access to said electronic document authoring, development and distribution system; permitting restricted access to said third party to selected functions of said electronic document authoring, development and distribution system; and, eliminating all access restrictions to said selected functions in said electronic document authoring, development and distribution system which were imposed in said permitting step when said third party registers as a registered user of said electronic document authoring, development and distribution system.(see column 2-27 lines 5-56)

#### CONCLUSION

#### Response to Arguments

5. Applicant's arguments files on 1/13/03 have been fully considered but they are moot in view of new grounds of rejections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clement B Graham whose telephone number is 703-305-1874. The Examiner can normally be reached on 7am to 5pm.

Art Unit: 3628

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 703-308-0505. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-0040 for regular communications and 703-305-0040 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

CG  
March 8, 2004

A handwritten signature in black ink, appearing to read "F. Sough".

AY 3628